THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte STEN R. GERFAST, EUGENE S. JOHNSON,
EDDIE T. MORIOKA, THEODORE A. SCHWARZ
and ROBERT W. TAPANI

_____

Appeal No. 95-0833
Application 08/161,978[1]

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ON BRIEF

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Before URYNOWICZ, THOMAS and KRASS, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

[1] Application for patent filed December 3, 1993. According to the appellants, this application is a continuation of Application 07/945,599, filed September 16, 1992, now abandoned, which is a continuation of Application 07/732,729, filed July 18, 1991, now abandoned, which is a continuation of Application 07/464,290, filed January 12, 1990, now abandoned, which is a continuation-in-part of Application 07/322,617, filed March 13, 1989, now abandoned.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claims 10 to 13, which constitute all the claims remaining in the application.

The pertinent portion of independent claim 10 on appeal is clause b:

> a second indicator opening indicating the nature of the tape in the data tape cartridge, said second indicator opening extending around a corner from the front to the side of the data tape cartridge such that a tape drive sensor positioned on either said front or said side of said data tape cartridge could detect said second indicator opening.

There are no references relied on by the examiner.

Claims 10 to 13 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to provide an adequate written description of the claimed invention as well as failing to provide an enabling disclosure thereof.

Rather than repeat the positions of the appellants and the examiner, reference is made to the briefs and the answer for the respective details thereof.

OPINION

We reverse both rejections.

"The test of enablement is whether one reasonably skilled in the art could make or[sic and] use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." United States v. Telectronics, Inc., 857 F.2d 778,785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), citing Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986). The specification need not disclose what is well known in the art. In re Buchner, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991).

The test to be applied under the written description portion of 35 U.S.C. § 112, first paragraph, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of later claimed subject matter. Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1565, 19 USPQ2d 1111, 1118 (Fed. Cir. 1991); rehearing denied, (Fed. Cir. July 8, 1991) and rehearing en banc denied, (Fed. Cir. July 29, 1991).

It is noted that claims 10 through 13 were not originally filed claims. They were added initially by an amendment on December 3, 1993, with the current version of claim 10 being entered in the amendment filed on March 3, 1994. None of the

originally filed claims contains subject matter relating to the disputed language set forth above. As such, we must look to the originally filed specification to reach a proper determination of this issue. We also characterize the drawings as they were originally filed, and not renumbered in accordance with the extensive file history in this application. Further, we note that the examiner's reasoning for lack of "support" implicitly refers to the written description portion of 35 U.S.C. § 112, first paragraph. In re Higbee, 527 F.2d 1405, 1406, 188 USPQ 488, 489 (CCPA 1976).

The initial portion of claim 10's clause b reproduced earlier is that the second indicator opening extend around a corner from the front to the side of the data tape cartridge. The only embodiment among the seven figures originally presented in this application which would appear to correspond to this language is that embodiment shown in Fig. 6. Our study of the drawings as filed, as well as the written description portion of the specification as filed, leads us to conclude that appellants' arguments with respect to the Fig. 4 embodiment are misplaced since only Fig. 6 can be construed in any manner to have an opening which extends around the corner from the front to the

side of the cartridge. This is apparent from an inspection of Fig. 6.

The corresponding language initially found in the specification as filed describing this figure is the following at page 8, lines 16 to 21:

> A recess 100 is used, and in this embodiment it preferably extends to the side wall such that portion 150 of the front wall is not present. This provides a location that a first switch in a suitably adapted drive may sense to determine whether the cartridge is of the present invention (emphasis added).

In accordance with the initial figures, Fig. 3 shows that the cartridge front wall is labeled as element 18, the front wall portion thereof is labeled 150 and the edge wall to the right of the figure is labeled 41. A study of the specification as a whole indicates that the language just quoted above indicating that a switch determines whether the cartridge is of the present invention corresponds to the second indicator of clause b of claim 10 on appeal in such a manner that it would indicate the nature of the tape therein.

In the modified Fig. 6 embodiment discussed at page 11 of the specification, one in which four switches are utilized by the tape drive, the following is indicated at lines 7 through 11:

> For the switch which determines which type of cartridge is present, the preferred area is

> the sidemost portion of the recess 100, i.e., in the position where the front wall portion 150 (see Figure 3) is present in a previously used cartridge (emphasis added).

The language here indicates a correspondence between the initial description of Fig. 6 and that of Fig. 3, although it may have been better stated in such a manner to indicate that the front wall portion 150 of Fig. 3 would have been indicated to be a part of the prior art cartridge.

The examiner's new matter of objection under 35 U.S.C. § 132 and the basis of the current rejections under 35 U.S.C. § 112, relate to the language inserted at page 11, line 12 of the specification by amendment on March 3, 1994, with the current amended version of claim 10 on appeal:

> As will be apparent from the drawing, this sidemost portion of the opening 100 also can be detected by a drive sensor positioned either at the front or the side of the cartridge (emphasis added).

Continuing in the same paragraph at page 11, lines 14 to 18 state the following:

> For the switch which determines write protection for a previously used cartridge,

> the preferred area is the other portion of the recess 100, as that is the location of the file protect device in presently used cartridges (emphasis added).

Again, it would have been perhaps better stated that the location of prior art industry standard cartridges would have utilized the so-called other portion of the recess 100 in a manner to be consistent with that initially described in location area 100 of Fig. 3.

Our assessment of these teachings and showings of the specification and drawings as originally filed is consistent with appellants' comments made at the bottom of page 8 of the principal Brief on appeal that the claimed data cartridge having two detectable openings comprise the first opening being recess 100 at the left side thereof as shown in Fig. 6 and the second opening being the right side of the same recess opening 100 also depicted in Fig. 6. Since the industry standard location of the first indicator opening in clause a of claim 10 on appeal is write-protected and permanently open, a portion of region 100 of necessity would comprise this first indicator opening. The description at page 11, lines 14 through 18, quoted above, indicates that the preferred area for the write protection for previously used cartridge is the "other" or left portion of the

recess 100 and, in conjunction with the remaining quoted teachings at the noted specification pages 8 and 11, the "sidemost portion" must be the right portion of recess 100 as depicted in Fig. 6.

Although there is no explicit, plainly stated or plainly shown teachings or suggestions in the disclosures and drawings as filed, we agree with the inserted language at page 11, line 12, that it would have been apparent from the drawing to the artisan that the location of the switching mechanism or sensor in the tape drive itself to sense what type of cartridge is present,

that the drawing would have implied to the artisan in the Fig. 6 representation, that the switch of the tape drive could be located in the region of the corner of the cartridge either on the front of portion 18 or on the side of portion 41 of the cartridge itself. These findings are consistent with the following guidance.

The manner in which the specification as filed meets the written description requirement is not material. The requirement may be met by either an express or an implicit disclosure. In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). An

invention claimed need not be described in ipsis verbis in order to satisfy the written description requirement of 35 U.S.C. § 112, first paragraph. In re Lukach, 442 F.2d 967, 969, 169 USPQ 795, 796 (CCPA 1971). The question is not whether an added word was the word used in the specification as filed, but whether there is support in the specification for the employment of the word in the claims, that is, whether the concept is present in the original disclosure. See In re Anderson, 471 F.2d 1237, 1244, 176 USPQ 331, 336 (CCPA 1973).

When the subject matter of claim 10 is considered as a whole, the claimed tape drive is only passively claimed. What is positively claimed and disclosed is a cartridge to be placed into a suitable tape drive. What is positively recited in clause b of claim 10 is that the second indicator opening extends around a corner from the front to the side of the tape cartridge. Such is clearly shown in Fig. 6 as indicated earlier. The location of the sensor or switches in the tape drive itself, which again is passively claimed in claim 10, is not shown in Fig. 6 but discussed only in a general manner in the specification as filed. Thus, the other question language of the examiner of clause b of

claim 10 on appeal "such that a tape drive sensor positioned on either said front or said side of said data tape cartridge could detect said second indicator opening" is a passive recitation applicable to the passively recited tape drive.

In view of all of these considerations, it is apparent that we must reverse the rejection of claims 10 to 13 under the written description portion of the first paragraph of 35 U.S.C. § 112. We reach a similar conclusion as to the enablement rejection as well. The initial written portion of the specification as well as the initial drawing figures 1 to 3 clearly indicate and teach to the artisan what is well-known in the art, especially making reference to industry standard

locations for various sensing or switching elements in tape drives for particular industry standard tape cartridges. The other figures are discussed having different front or side switch locations within the tape drive as well. Thus, there appears to be no enablement question rising to the level of undue experimentation to the artisan which would justify sustaining a rejection regarding the location of the tape drive sensor being

positioned either on the front or the side of the tape cartridge.[2]

In view of the foregoing, we have reversed both rejections of claims 10 to 13 under 35 U.S.C. § 112, first paragraph. Therefore, the decision of the examiner is reversed.

REVERSED

[2] Since our review of the written description and drawings in Fig. 6 as filed indicates to us that there was an implicit disclosure of the location of a switching element either on the side or the front of the cartridge to be consistent with the clearly disclosed Fig. 6 embodiment showing a second indicator opening extending around a corner from the front to the side of the cartridge, the outstanding objection under 35 U.S.C. § 132 to the amendment to page 11, line 12, filed on March 3, 1994 should be withdrawn.

STANLEY M. URYNOWICZ, JR. Administrative Patent Judge	)
JAMES D. THOMAS Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
ERROL A. KRASS Administrative Patent Judge	)

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